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Serial No. 10/625,282
Docket No. 54953-2 ORD**Certificate of Transmission under 37 CFR 1.8**

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2. Notice of Appeal;
3. Pre-Appeal Brief Request for Review;
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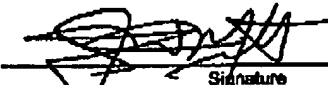
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PTO/SB/33 (07-05)

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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 54593-2 ORD | |
|---|--|--|-----------------------------|
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name <u>Joseph W. Mott</u> | | Application Number 10/625,282 | Filed 07-22-2003 |
| | | First Named Inventor Frederick G. Payne | |
| | | Art Unit 3852 | Examiner Basil Katcheves |
| Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. | | | |
| This request is being filed with a notice of appeal. | | | |
| The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided. | | | |
| I am the | |  | |
| <input type="checkbox"/> applicant/inventor. | | Signature | |
| <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) | | Joseph W. Mott | |
| <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>35,621</u> | | Typed or printed name | |
| <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ | | 602-262-5866 | |
| | | Telephone number | |
| | | 3 November 2005 | |
| | | Date | |
| NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below. | | | |
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PRE-BRIEF HEARING STATEMENT BY APPLICANT

Applicant respectfully submits that the rejections set out in the Office Action dated May 3, 2005, are clearly not proper. The Section 102 rejection of claims 1-4 and 10 over the Goergen reference is based on an unsupported misreading of what Goergen discloses.

Applicant's claim 1 recites:

1. A method of discouraging the roosting or nesting of birds on structures comprising the steps of identifying roosting zones on the structure and applying thereto a slide comprising a formed sheet of material having a slick outer face and mounted to impose a plurality of angled slide surfaces that inhibit a bird's standing.

Goergen does not disclose all the limitations of claim 1. In particular, Goergen does not disclose a formed sheet of material . . . mounted to impose a plurality of angled surfaces that inhibit a bird's standing.

As may readily be seen in FIGs. 1-4, the Goergen device presents a single angled slick surface (identified as 4) to inhibit standing birds. A single surface is not a plurality of surfaces. (Applicant notes that Goergen FIGs 1 and 2 show three sides to the structure but only one surface is imposed so as to inhibit the bird.) To wriggle out of this dilemma, the Examiner misinterprets Goergen FIG. 4 as showing a "plurality of angled surfaces (FIG. 4: F, 30)." [Office Action, P. 2] Here the Examiner fails to comprehend what Goergen discloses (or perhaps did not read the specification). FIG. 4 shows a plastic strip (30) inclined at an angle and fixed to the horizontal and vertical surfaces by "beads of adhesive foam (f)." [Col 2, l. 59-64]

There is no possible way that these beads of adhesive can be considered additional angled slide surfaces combined with the plastic sheet. Moreover, these beads of adhesive are not part of the angled plastic sheet and thus do not meet the limitation that the device be a formed sheet having a plurality of angled surfaces that present to the birds. The Examiner's argument that Goergen discloses an exposed surface that "contains various angles capable of being exposed to bird activity" is plain wrong; Goergen shows a single slide surface and two beads of adhesive.

Claims 2-4 and 10 depend from claim 1 and are not anticipated if claim 1 is anticipated.

The Examiner's rejection of claim 5 as obvious over Goergen and McDonald is similarly without any basis. Claim 5 recites a triangular prism with a partially open bottom and an inverted "V" cross section. The Examiner purports to find this structure by combining FIG. 2 of Goergen with FIG. 3 of McDonald. The Goergen figure shows a long triangular prism fitted to an I-beam. The McDonald figure shows an inverted cone on a circular stack. It is questionable whether we could fairly call McDonald an inverted "V." But it is beyond dispute that there is no way to combine the cone shape with a strip on a horizontal I-beam. Where could the cone possibly go? Where combining references is physically impossible, they cannot form the basis of an obviousness rejection.

Finally, the rejection of claim 11 as anticipated by Goergen exhibits plain error. Claim 11 recites:

11. A method of discouraging the nesting or nesting of birds on rooftop structures comprising the steps of identifying roosting zones on the rooftop structure and applying thereto a slide comprising a sheet of material having a slick outer surface and mounted to impose an angled surface that inhibits a bird's standing, wherein the slide comprises a sheet that follows a slope of the rooftop structure and covers the nesting zone.

The Examiner states that the Goergen sheet "follows the slope of a roof" and points to FIG. 1 [Office Action, P. 2]. But FIG. 1 does not show a "roof;" it shows an I-beam. Moreover, the "slope" is either horizontal or vertical, and the Goergen sheet does not follow either.

Applicant's specification [P. 6, last three paragraphs and FIGs. 7 and 8] illustrate to persons of ordinary skill what a "sloped roof" is and what "follows a slope of the rooftop structure" means. Goergen does not anticipate the claim limitations.

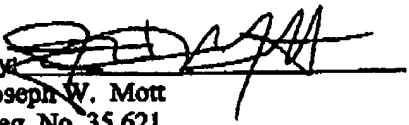
Claim 12 depends on claim 11 and is valid because claim 11 is valid.

For the foregoing reasons, the application should be allowed on the existing claims.

Respectfully submitted,

Frederick G. Payne

November 3, 2005

By 
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